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Paper No. 8

LAFF WHITESEL & SARET LTD
401 NORTH MICHIGAN AVENUE SUITE 1700
CHICAGO, IL 60611

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In re Application of
Bendiner
Reissue Application No. 09/721,586
Filed: November 22, 2000
Attorney Docket No.: 5565x4
For: PRESERVATIVE FOR ORGANIC
MATERIALS

SEP 6 2001

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(b) **OFFICE OF PETITIONS**

This is in response to the petition under 37 CFR 1.47(b), filed May 17, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed November 22, 2000 without an executed oath or declaration and naming Bernard Bendiner as sole inventor. Accordingly, on December 13, 2000, a "Notice to File Missing Parts of Reissue Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing. The instant petition was filed in response.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 USC 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages.

The petition lacks items (1) and (2) above.

As to item (1), supporting evidence that the non-signing inventor cannot be reached, was ever presented with a copy of the application papers (specification, claims and drawings), or, having been presented with the application papers, refused to sign the oath or declaration has not been presented. The declarations referenced in the instant petition do not appear in the official application file.

Petitioner is reminded that "before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney." See, MPEP 409.03(d).

Evidence that the non-signing inventor was presented with a copy of the application papers (specification, claims and drawings), and, having been presented with the application papers, refused to sign the oath or declaration, is required. Further proof of the pertinent events should be made by someone having first hand knowledge of the events in the form of an affidavit or declaration. In particular, the affidavit or declaration must set forth the manner in which the application papers were presented to the non-signing inventor. Petitioner should include copies of dated cover letters and/or mailing receipts as evidence that the non-signing inventor was presented with a copy of the application papers or having been presented with the application papers, refused to sign the oath or declaration. If oral refusals were made after such time as the non-signing inventor was presented with the application papers, that fact along with the time and place of the refusal must be stated in an affidavit or declaration signed by the person to whom the refusals were made. If written refusals were made after such time as the inventor was presented with the application papers, petitioner should supply evidence of such written refusals in any renewed petition.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. A declaration signed by one other than the named inventor should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer on behalf of and as agent for the non-signing inventor. The corporate officer's title/position must be identified in the declaration. If an officer is unavailable to execute the declaration, the declaration may be signed on behalf of the corporation by one whose proof of signing authority has been submitted to the Office, such as the corporation's attorney. See, MPEP 409.03(b). Additionally, the name, last known address, and citizenship of the non-signing inventor must also appear in the oath or declaration. Any renewed petition must be accompanied by a declaration in full compliance with 37 CFR 1.63.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

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Telephone inquiries related to this decision may be directed to
Petitions Attorney Alesia M. Brown at (703) 305-0310.

for D Wood

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy